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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,475	06/01/2001	Toru Kurokawa	0649-0786P	1027
2292	7590	08/12/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HUNTSINGER, PETER K	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/870,475		KUROKAWA, TORU	
	<b>Examiner</b>		<b>Art Unit</b>	
	Peter K. Huntsinger		2624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment filled on 26 May 2005 has been entered in full.

### *Response to Argument*

2. Applicant's arguments filled on 25 May 2005 regarding claims 1-19 have been fully considered but they are not persuasive.

On page 15-18 of the remarks, applicant argues in substance that:

3. **Garfinkle et al. does not disclose a recording medium mounted on a terminal wherein the mounted recording medium includes image data, server-connection address information, and a designated print-order acceptor information**

a. Examiner respectfully disagrees. Garfinkle et al. disclose the image data either being a roll of film including an access code written on a barcode (col. 4, lines 14-20), or can be present as digital images stored with associated information on a local machine of the photographer (col. 4, lines 21-23). Both are a recording medium, which is mounted by either placing the images on a scanner or by connecting the camera to the terminal (See Fig. 9b). Garfinkle disclose an access code, which identifies the location of the image server where the images are stored (col. 4, lines 6-10), and with the access code including the store

location where the film was received (col. 4, lines 60-65). Therefore, Garfinkle et al. disclose the invention as specified by claims 1, 10, and 16.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 7-19, 20 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Garfinkle et al. U.S. Patent 6,017,157.

Referring to claims 1 and 10, Garfinkle et al. disclose an order receiving server (image server 16 of Fig. 1, col. 3, lines 62-67, col. 7, lines 4-15), and a terminal unit (upload interface A of Fig. 1, col. 4, lines 21-33), when the recording medium (computer storage, col. 3, lines 56-58), storing a digital image data, a server-connection address information, and a designated print-order acceptor information, (col. 4, lines 60-65) is mounted to the terminal unit, said terminal unit is connected to said order receiving server based on said server-connection address information so as to transmit said designated print-order acceptance information and at least a part of said digital image data to said order receiving server (3f of Fig. 3, col. 4, lines 21-33); and further wherein said order receiving server (image server 16 of Fig. 1, col. 3, lines 62-67) outputs a print command data based on the received digital image data, and a command data by which a receiver of an order in accordance with said designated print-order acceptor

information can receive an image print that is printed based on said print command data (col. 7, lines 4-15).

Referring to claims 2, 11, and 17, Garfinkle et al. disclose an order receiving server that is a WWW server (col. 5, lines 1-10).

Referring to claims 3, 12, and 18, Garfinkle et al. disclose server-connection address information and designated print-order acceptor information (col. 4, lines 60-67) are recorded on said recording medium as URL data for specifying a WWW page created for each receiver of the order (col. 6, lines 5-13), and said terminal unit, after acquiring the data of the WWW page for each of said specified receivers of the order, transmits said digital image data to said WWW server (col. 9, lines 14-17).

Referring to claim 4, Garfinkle et al. disclose data of the WWW page for each of said specified receivers of the order includes data for acquiring data of a WWW page of another receiver than the receiver of the order according to said designated print-order acceptor information (col. 6, lines 5-14).

Referring to claims 7 and 13, Garfinkle et al. disclose server-connection address information and designated print-order acceptor information are recorded when the digital image data is recorded in said recording medium (col. 4, lines 60-67).

Referring to claims 8 and 14, Garfinkle et al. disclose designated print-order acceptor information is data that specifies a receiver of request to whom creation of said recording medium has been requested (5j of Fig. 5D, col. 7, lines 47-52).

Referring to claims 9 and 15, Garfinkle et al. disclose server-connection address information and said designated print-order acceptor information are renewable (4c of Fig. 4, col. 8, lines 1-7).

Referring to claim 16, Garfinkle et al. disclose digital image data obtained by developing a photographic film before development and carrying out a photoelectrical conversion of the image after development, digital image data obtained by carrying out a photoelectrical conversion of the photographic film after development or an image of an image print, and digital image data recorded on other recording mediums is recorded on a single recording medium (col. 2, lines 53-64), and there is included a step of recording connection address data to a print order receiving server connected to a network, designated print-order acceptor information, and data for causing said terminal unit to connect to said order receiving server through said network (col. 4, lines 60-65) when the recording medium is mounted to a terminal unit and to transmit said designated print-order acceptor information to said order receiving server (3f of Fig. 3, col. 9, lines 21-33).

Referring to claim 19, Garfinkle et al. disclose designated print-order acceptor information is data that specifies a provider to whom provision of said recording medium is requested (col. 4, lines 60-65).

Referring to claim 20, Garfinkle et al. disclose an image print ordering system, comprising: one or more print service receiving servers connected to a network (image server 16 of Fig. 1, col. 3, lines 62-67, col. 7, lines 4-15); and a terminal configured to connect to the network and configured to mount a recording medium (upload interface A

of Fig. 1, col. 4, lines 21-33), wherein information stored within the recording medium (col. 4, lines 6-23) includes connection address data of a selected print service receiving server among the one or more print service receiving servers (col. 6, lines 5-13) requested service shop data, and image data (col. 4, lines 60-65), the terminal is configured to transmit print request data and the image data to the selected print service receiving server via the network based on the connection address data (3f of Fig. 3, col. 4, lines 21-33), and the selected print service receiving server configured to transmit reception data to a requested service shop corresponding to the requested service shop data to fulfill a print order corresponding to the print request data and the image data transmitted from the terminal (col. 9, lines 14-25).

Referring to claim 29, Garfinkle et al. disclose a method for fulfilling a print request from a terminal by a print service receiving server, the method comprising: receiving a print request to print one or more images from a terminal via a network (3f of Fig. 3, col. 4, lines 21-33); and transmitting reception data to a requested service shop to fulfill a print order corresponding to the print request data and the image data received from the terminal (col. 9, lines 14-25), wherein the print request is generated by the terminal based on information stored in a recording medium mounted on the terminal (col. 6, lines 5-23), and wherein information stored in the recording medium include connection address data of the print service receiving server, service shop data of the requested service shop, and the image data (col. 4, lines 60-65).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 6, 23, 24, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al. U.S. Patent 6,017,157 as applied to claims 1-5, and 20 above, and further in view of Fanning et al. U.S. Patent 6,742,023.

Referring to claims 5, 23, and 31, Garfinkle et al. disclose the image print order system of claims 1-5 but do not disclose expressly accessing an alternative receiver when an acceptor cannot receive the order. Fanning et al. disclose accessing a different server whenever a file cannot be transferred from a server (col. 7, lines 49-65). Fanning et al. disclose the method of accessing a server through FTP (col. 7-8, lines 66-68, 1-6), which is a protocol for accessing WWW pages and files. Garfinkle et al. and Fanning et al. are combinable because they are from the same field of electronic file transferring. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the image print order system of Garfinkle et al. to access a website of another server whenever a server becomes unavailable. The motivation for doing so would have been to provide an alternative server for file transfer if one server becomes unavailable. Therefore, it would have been obvious to combine Fanning et al. with Garfinkle et al. to obtain the invention as specified in claim 5, 23, and 31.



Referring to claim 6, Garfinkle et al. disclose the image print order system of claims 1-5 but do not disclose expressly accessing an alternative receiver when an acceptor cannot receive the order. Fanning et al. disclose accessing a different server whenever a file cannot be transferred from a server (col. 7, lines 49-65). Garfinkle et al. and Fanning et al. are combinable because they are from the same field of electronic file transferring. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to allow the image print order system of Garfinkle et al. to access a website of another server whenever a server becomes unavailable. The motivation for doing so would have been to provide an alternative server for file transfer if one server becomes unavailable. Therefore, it would have been obvious to combine Fanning et al. with Garfinkle et al. to obtain the invention as specified in claim 5.

Referring to claim 24 and 32, Garfinkle et al. disclose 24. the image print ordering system of claim 23, wherein the selected print service receiving server is configured to provide to a user of the terminal one or more available service shops capable of fulfilling the print order, and receive the service shop chosen by the user from the one or more available service shops (col. 8, lines 8-22). Fanning et al. disclose determining that the requested server is unavailable (col. 7, lines 49-65).

5. Claims 21, 22, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al. U.S. Patent 6,017,157 as applied to claims 20 and 29 above, and further in view of Subramaniam et al. U.S. Patent 6,081,900.

Referring to claims 21 and 30, Garfinkle et al. disclose a print service receiving server but does not disclose expressly transmitting reception data to an alternate shop if it is determined that the service shop is an agency. Subramaniam et al. disclose determining whether a website is to be redirected, and transmitting the data to an alternative website when it is determined that the website is to be redirected (col. 7, lines 1-11). Seeing that the system of Garfinkle et al. utilizes an HTML interface to transmit the reception data, a HTTP redirection would transmit the data to another website, which would be an alternate service shop. The determination of whether the website is an agency is made depending on whether the website redirections the data or not. Garfinkle et al. and Subramaniam et al. are combinable because they are from the same field of internet data transferring. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to redirect the data to another shop if the requested shop is determined to be a agency. The motivation for doing so would have been to transfer the data to the correct site if the website has been moved. Therefore, it would have been obvious to combine Subramaniam et al. with Garfinkle et al. to obtain the invention as specified in claims 21 and 30.

Referring to claim 22, Garfinkle et al. disclose the image print ordering system of claim 21, wherein the alternate service shop is configured to deliver a resulting print to the requested service shop (col. 9, lines 34-41).

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al. U.S. Patent 6,017,157.

Referring to claim 25, Garfinkle et al. disclose the image print ordering system of claim 20, wherein the requested service shop originally records its data as the requested service shop data to the recording medium (col. 5, lines 16-24). Garfinkle et al. disclose the scanning center, which records the data, can be the same entity as the fulfillment center (col. 3, lines 16-19). It would be obvious for the user to receive the service shop data associated with the access code when the image is downloaded. The information would be necessary to re-access the image in order to view or order more copies.

7. Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garfinkle et al. U.S. Patent 6,017,157 as applied to claim 20 above, and further in view of Chui et al. U.S. Patent 6,657,702 and Hurtado et al. U.S. Patent 6,611,812.

Referring to claim 26, Garfinkle et al. disclose the system of claim 20, but does not disclose expressly an automatic run program. Chui et al. disclose uploading images for ordering from a CD (col. 5, lines 13-29). Garfinkle et al. and Chui et al. are combinable because they are from the same field digital picturing ordering. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to upload digital images for ordering from the recording medium of a CD. The motivation for doing so would have been to allow the greater flexibility in uploading images by utilizing the universal format of a CD-ROM. Hurtado et al. disclose automatically executing the automatic run program when the recording medium is mounted to the terminal to connect to the selected print service receiving server (col. 84, lines 45-60).

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Garfinkle et al. and Hurtado et al. are combinable because they are from the same field computer systems. At the time of the invention, it would have been obvious to a person of ordinary skill to automatically run a program when a CD is inserted. The motivation for doing so would have been to eliminate the need for the user to manually load the program on the CD. Therefore, it would have been obvious to combine Chui et al. and Hurtado et al. with Garfinkle et al. to obtain the invention as specified in claim 26.

Referring to claim 27, Hurtado et al. disclose the image print ordering system of claim 26, wherein the recording medium further includes a to-network connection program operated by the automatic run program (web browser, col. 84, lines 45-60).

Referring to claim 28, Chui et al. disclose the image print ordering system of claim 26, wherein the recording medium further includes a viewer program for viewing and selecting images and generating the print request data, the viewer program being operated by the automatic run program (col. 5, lines 4-29).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH



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